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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,331	04/05/2000	Shozo Hattori	35.C14393	6706
5514	7590	03/03/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			NGHIEM, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/543,331	HATTORI ET AL. 8X	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 August 2003 and 25 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21, 24 and 25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

The Amendment filed on August 25, 2003 has been acknowledged.

***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2003 has been entered.

***Claim Objections***

2. Claim 21 is objected to because of the following informalities:  
"uncomprssed" (line 18) should be – uncompressed --.  
Appropriate correction is required.

***Claim Rejections - 35 USC 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. (EP 756 935).

Ono et al. discloses all the claimed features of the invention including:

- an ink tank (Fig. 1) comprising:
  - an ink tank main body (20) including an ink supply portion (23's) and an atmospheric communication portion (column 5, lines 4-5);
  - an ink absorbent (24-26) installed in the ink tank main body (Fig. 1), said ink absorbent having thermally-processed faces (surfaces of 26 excluding top and bottom surfaces, Figs. 3's) and at least one non-thermally-processed cut face (top and bottom surfaces of 26, Figs. 3's);
  - said ink absorbent in an uncompressed state has a content volume larger than that of said ink tank main body (Fig. 3a), and said non-thermally processed cut face is cut (Fig. 2) in a state where said ink absorbent is compressed in a compression direction and a compression state which are the same as those when said ink

absorbent is inserted into said ink tank main body (top and bottom surfaces of 26 remain cut, Figs. 3's);

- said ink absorbent is inserted into said ink tank main body in a compression direction and a compression state which are the same as those when said ink absorbent is cut to form said non-thermally processed cut face (26 is compressed in 51, Fig. 3c, vs. 22c, Fig. 1).

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Boyd et al. (EP 709 211).

Boyd et al. discloses all the claimed features of the invention including:

- an ink tank (Figs. 4, 5) comprising:

- an ink tank main body (Figs. 4, 5) including an ink supply portion (183-185) and an atmospheric communication portion (148, 154, 156);

- an ink absorbent (130, 132, 134, 214) installed in the ink tank main body (Fig. 5), said ink absorbent having thermally-processed faces (left and right side surfaces of 214, Fig. 7) and at least one non-thermally-processed cut face (surfaces excluding side surfaces of foam, Fig. 4, top and bottom surfaces of 214, Fig. 7);

- said ink absorbent in an uncompressed state has a content volume larger than that of said ink tank main body (page 8, lines 45-46), and said non-thermally processed cut face is cut (Fig. 4), said ink absorbent is compressed in a compression direction and a compression state (compression of 210, 212 on 214, Figs. 6, 7) which are the same

as those when said ink absorbent is inserted into said ink tank main body (compression of 176, 178 on 130, Fig. 5).

Boyd et al. further discloses that said non-thermally processed cut face is cut after said ink absorbent is compressed (Abstract, lines 8-10) in a compression direction and a compression state which are the same as those when said ink absorbent is inserted into said ink tank main body (Figs. 6, 7).

However, it does not seem to matter structurally whether said non-thermally processed cut face is cut in or after a state where said ink absorbent is compressed. It has been held that determination of patentability of a product is based on the product itself and does not depend on its method of production. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koitabashi et al. (US 5,509,140) in view of Boyd et al..

Koitabashi et al. discloses the following claimed features of the invention:

Regarding claim 21, an ink tank (1, Fig. 3) comprising:

- a supply port (opening of 1 receiving 7) for leading out ink to the outside, an atmospheric communication port (13) for communication with the air outside, a negative pressure generating member installation chamber (4) in which an ink absorbent (3) is contained, a liquid storage chamber (6) communicated with said negative pressure generating member installation chamber through a communication passage (8) to store ink to be supplied to said negative pressure generating member installation chamber, said liquid storage chamber having substantially closed with the exception of said communication passage (Fig. 3), and a partition wall member (5) defining said communication passage and partitioning said negative pressure generating member installation chamber and said liquid storage chamber, said supply port being adapted to receive an ink supply portion (7) of an ink jet head into an inside of said negative pressure generating member installation chamber (Fig. 3),

- said ink absorbent is arranged by a fibrous material (3), an outer surface thereof is thermally processed into an outer shape configured for containment in the interior of said ink tank (column 11, lines 58-63);

- the face of said ink absorbent facing said partition wall member (Fig. 3).

- said ink absorbent in an uncompressed state has a content volume larger than that of said negative pressure generating member installation chamber (3 is compressed in 4 and has the same volume as 4, Fig. 1, thus, in an uncompressed state, 3 has a larger volume than 4).

Even though Koitabashi et al. does not discloses that the face of said ink absorbent facing said partition wall member is formed by cutting, the face of the present invention does not structurally distinguish over the face disclosed by Koitabashi et al.. It has been held that determination of patentability of a product is based on the product itself and does not depend on its method of production. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

Koitabashi et al. further does not disclose:

- regarding claim 21:

- said ink absorbent is contained in a manner that a side face of said ink absorbent corresponding to said supply port of said ink tank is a non-thermally processed cut face;

- said non-thermally processed cut face is cut in a state where said ink absorbent is compressed in a compression direction and a compression state which are the same as those when said ink absorbent is inserted into said negative pressure generating member installation chamber and vice versa.

- regarding claim 24, Koitabashi et al. does not disclose that said non-thermally processed face is arranged by cutting a thermally processed face and has a hardness softer than the thermally processed face.

However, regarding claim 24, Boyd et al. discloses the limitations as discussed above for the purpose of obtaining the desired foam size for fitting into an ink tank.

Regarding claim 21, Boyd et al. further discloses that said ink absorbent (130, 132, 143) is contained in a manner that a side face of said ink absorbent corresponding to said supply port of said ink tank is a non-thermally processed cut face (Fig. 5) arranged by cutting a thermally processed face (Abstract, lines 8-10) for the purpose of fitting the absorbent into the ink supply port portion of the ink tank.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Koitabashi et al. with non-thermally processed cut face and an ink absorbent as disclosed by Boyd et al. for the purpose of easy fitting the absorbent into the ink tank and the ink supply port portion of the ink tank.

#### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2272. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (571) 272-2269. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
**MICHAEL NGHIEM**  
**PRIMARY EXAMINER**

Michael Nghiem

February 17, 2004